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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,495	07/26/2001	Gene Summy	TLSLAB.001A	6808
20995	7590	06/30/2004	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			WOOD, KIMBERLY T	
			ART UNIT	PAPER NUMBER
			3632	

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/915,495

Applicant(s)

SUMMY, GENE

Examiner

Kimberly T. Wood

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,7 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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This is an office action for serial number 09/915,495.

***Claim Rejections - 35 USC § 112***

Claim 1 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a first flap to engage a vertical wall, does not reasonably provide enablement for the first and second flap to engage a wall. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Figure 6 shows that the first flap is the only flap to engage a vertical wall.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 7 rejected under 35 U.S.C. 102(b) as being anticipated by De Boer 5,927,039. De Boer discloses a window frame (12), a first member comprising a horizontal (58, horizontal) and a vertical (58 vertical), a first flap

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(60), and second flap (62), and a web (56) having an adhesive backing (52). The first member being made of water-impermeable flashing material.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBoer 5,927,039 in view of Beale 3,451,178. DeBoer discloses all of the limitations of the claimed invention except for the web being a separate piece secured along and partially overlapping the edges of the first and second flaps and the first member being of asphalt. Beale teaches that it is known to have a flashing (figure 4) having a first member comprising a horizontal (16) and a vertical (13) seating flange, a first flap (15), and second flap (18), and a web (21) having edges and secured along and partially overlapping the adjacent edges of the first and second flaps being made of water-

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impermeable flashing material. It would have been obvious to have modified De Boer to have the web member as taught by Beale since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art without destroying the invention. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeBoer 5,927,039 in view of Tajima et al. (Tajima) 4,248,926. DeBoer discloses all of the limitations of the claimed invention except for first member being of asphalt based flashing material. Tajima teaches that it is known to have a flashing being made of asphalt based material (column 3, lines 8ff, see column 1, lines 10ff "bitumen" as used hereinbelow may be replaced by the term "asphalt") having an adhesive backing (figure 4, column 3, lines 60ff). It would have been obvious to one having ordinary skill in the art at the time of the invention to have modified De Boer to have made the flashing of asphalt based flashing material as taught by Tajima since, both De Boer and Tajima are mechanical equivalent flashing members made of water impermeable flashing material and it has been held to be within the general skill of a worker in the art to select a known

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material on the basis of its suitability for the intended use without producing any unexpected results or destroying the invention.

Claims 1-3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Boer in view of Beale as discussed above. It would have been obvious to modified DeBoer to have substituted the first member including the horizontal and vertical seating flanges with the first and second flap as taught by Beale for the purpose of providing a better means of sealing the window.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeBoer 5,927,039 in view of Tajima et al. (Tajima) 4,248,926, as discussed above. DeBoer discloses all of the limitations of the claimed invention except for first member being of asphalt based flashing material. Tajima teaches that it is known to have a flashing being made of asphalt based material (column 3, lines 8ff, see column 1, lines 10ff "bitumen" as used hereinbelow may be replaced by the term "asphalt") having an adhesive backing (figure 4, column 3, lines 60ff). It would have been obvious to one having ordinary skill in the art at the time of the invention to have modified De Boer to have made the flashing of asphalt based flashing material as taught by

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Tajima since, both De Boer and Tajima are mechanical equivalent flashing members made of water impermeable flashing material and it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use without producing any unexpected results or destroying the invention.

#### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

#### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


The prior art discloses conventional flashing and sealing members and material.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly Wood whose telephone number is (703) 308-0539. The examiner can normally be reached on Monday-Thursday from 7:30 AM to 5:00 PM. Any inquiry of a general nature or relating to the status of this application should be

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directed to the Group receptionist whose telephone number is (703) 308-2168. The fax number for an Official

Amendment or Response is (703) 872-9306. The fax number for an Unofficial Amendment or Response is (703) 308-3686.

  
Kimberly Wood  
Primary Examiner  
June 24, 2003